REMARKS

Favorable consideration and allowance are respectfully requested for pending claims 1 – 52 in view of the foregoing amendments and the following remarks.

The rejection of claims 47 and 50 – 52 under 35 U.S.C. 112, first paragraph, as allegedly lacking enablement is respectfully traversed.

Claim 50 is amended to delete the reference to diarrhea. Claim 51 is amended to delete the references to osteoporosis, ototoxicity, cerebral infarcts, and cerebral oedema. Claim 52 is amended to delete references to allergic reactions, gastritis, respiratory diseases and coughing.

The recent Office Action offers no explanation regarding why claim 47 remains rejected. The former Office Action indicated the specification is enabling for treating pain, see page 2 of the Office Action. This Office Action also indicated that the term "alleviating" in claim 47 was being interpreted as meaning completely curing. As explained in the previously-filed response, "alleviate" means lessen, not completely cure. Any specification that enables treating necessarily also enables alleviating. The most recent Office Action make the conclusory statement that this reasoning is unpersuasive, however the Office Action fails to offer any explanation as to why an other understanding of the term alleviating should be applied. Because the Office considers the specification enabling for treating pain, it must also consider the specification enabling for alleviating pain.

The enablement requirement is satisfied where the specification describes the claimed subject matter in such a way as to enable any person skilled in the art to which it pertains to make and/or use the invention. Thus, enablement is judged in view of the combined teachings of the specification and the knowledge of one skilled in the art.

The U.S. Court of Customs and Patent Appeals has stated that "[t]The first paragraph of § 112 requires nothing more than objective enablement. How such a teaching is set forth, either by the use of illustrative examples or by broad terminology, is of no importance." *In re Marzocchi,* 169 USPQ 367 , 369 (CCPA 1971). The court also added that "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." *In re Marzocchi,* 169 USPQ 367 , 370 (CCPA 1971). The present record includes no such statement or other explanation as to why the truth of the accuracy of statements in the disclosure should be doubted.

As indicated above, the burden is on the Patent Office to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. On the present record there is no explanation to cause any reason to doubt that the compounds would be active to treat the claimed conditions or diseases. On the present record, no reason has been offered to support the notion that the statements in the specification are not true or accurate.

Instead, the Office Action attempts to impose a heighten standard for enablement in the present application. In particular, the Office Action indicates that references need to be submitted showing the "well known utility of compounds related very closely in structure to the instant compounds or their efficacy in known animal models of specific disease conditions." The recent Office Action offers no citation supporting this standard for enablement. Indeed, the former part of the test cannot be satisfied by new compounds, as there may be no compounds related very closely in structure. Patentability of a new

method of use does not depend on whether there are closely related compounds which are already known. Further, the U.S. Patent and Trademark is not charged with considering the efficacy of compounds, as suggested by the latter part of the test suggested in the Office Action. Instead the U.S. Food and Drug Administration is the agency that addresses issues of safety and efficacy. This concept is reflected in the MPEP at § 2107.03(V).

Enablement is satisfied where a person of skill in the art would have a reasonable expectation of success in making and using the claimed invention. The MPEP, at § 2173.03, states that:

> The Federal courts have consistently reversed rejections by the Office asserting a lack of utility for inventions claiming a pharmacological or therapeutic utility where an applicant has provided evidence that reasonably supports such a utility. In view of this, Office personnel should be particularly careful in their review of evidence provided in support of an asserted therapeutic or pharmacological utility.

In the present instance, the specification indicates that the claimed compounds are active as NMDA antagonists, *see* paragraph [0011] and the experimental results on pages 55-57 of the specification. The present record includes no reason to not believe the truth of this statement, or even any assertion that the statement is not true. Thus, the present record objectively indicates that the claimed compounds are NMDA antagonists.

NMDA antagonists are known to be relevant to the conditions listed in claims 50-52. In addition to the literature cited in the specification and the most recently-filed reply, Applicants also point to the following:

Claim 50

Urinary incontinence: US 5,498,610 - col. 7, line 36 - relevant pages enclosed herewith
Pruritus: US 6,242,456 – example 4 - relevant pages enclosed herewith
Tinnitus aurium: 5,902,803 – col. 7, line 62 - relevant pages enclosed herewith

Claim 51

Epilepsy: J. Janusz Kulagowski, Expert Opinion on Therapeutic Patents, 6(10), (1996) - abstract enclosed herewith
Parkinson's disease: K. Kewal Jain, Expert Opinion on Investigational Drugs, 9(6), (2000)-Abstract enclosed herewith
Anesthesia: US 6,197,830 -relevant pages enclosed herewith
Huntington's disease: Annual Drug Data Report 1995, p.121, Compound 257448 - see Abstract previously provided
Glaucoma: US 6,083,941 - col. 3, line 7 - relevant pages enclosed herewith
Alcohol/drug abuse: US 5,962,496 – col. 5, line 21-22 – relevant pages enclosed herewith
Stroke: Expert Opinion on Therapeutic Patents, 6(10), (1996) - abstract
Cerebral ischemia: US 5,962,496 – col. 5, line 10 - relevant pages enclosed herewith
Hypoxia: US 5,962,496 – col. 5, line 11 - relevant pages enclosed herewith
Anoxia: Annual Drug Data Report 1995, p.989, compound 225249 - see Abstract previously provided
Anxiolysis: US 5,962,496 – col. 5, line 19 - relevant pages enclosed herewith

Claim 52

Schizophrenia: Expert Opinion on Therapeutic Patents, 6(10), (1996) - Abstract enclosed herewith
Alzheimer's disease: Expert Opinion on Investigational Drugs, 9(6), (2000) - Abstract enclosed herewith
Psychosis: US 5,498,610 – col. 7, line 35 - relevant pages enclosed herewith
AIDS dementia: Expert Opinion on Investigational Drugs, 9(6), (2000) - Abstract enclosed herewith
Encephalomyelitis: US 5,912,259 - Example 2 - relevant pages enclosed herewith
Tourette's syndrome: US 5,902,803 – col. 7, line 65 relevant pages enclosed herewith
Perinatal asphyxia: Annual Drug Data Report 1993, p,907-908, Compound 198235 - see Abstract previously provided
Inflammatory reactions: US 5,902,803 – col. 8, line 3 – relevant pages enclosed herewith
Depression: Annual Drug Data Report 1998, Compound 269005 - see Abstract previously provided
Drug or alcohol abuse: Expert Opinion on Investigational Drugs, 9(6), (2000) - Abstract enclosed herewith
Diabetes: US 5,162,311 – col. 15, line 44 relevant pages enclosed herewith
Cardiovascular diseases: US 5,234,956 – col. 2, line 26
Mental illnesses: US 5,061,721 - Column 2, line 36

Thus, based on the available literature, the NMDA receptor is known to be relevant to the presently claimed conditions. Because the claimed compounds are active on the NMDA receptor one of skill in the art would reasonably expect that the compounds would be operative on these conditions. Moreover, one of skill in the art could readily practice the claimed invention.

In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of claims 47 and 51 and 52 under 35 U.S.C. 112, second paragraph, as allegedly lacking definiteness is respectfully traversed.

The present Office Action offers no explanation of this rejection or response to the remarks in the previously-submitted reply. There is nothing indefinite about the term "alleviating" in claim 47 or "inhibiting" in claims 51 and 52. Any amount of alleviating or inhibiting is contemplated by the claim. Thus, the question is simply whether there is any alleviation or inhibition. A claim is not indefinite simply because it is broad. The relevant question is whether one of skill in the art could determine the scope of the claim. There is nothing about the claim language that would cause one of skill in the art any difficulty in determining the scope of the claim and whether some activity constituted infringement.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of claims 1-9, 11 and 15-24 under 35 U.S.C. § 103 over the Borrione and Kobayashi references are respectfully traversed.

The withdrawal of the prior novelty rejections based on these references is a tacit admission that the references do not teach the presently claimed compounds. Thus, neither of the references teaches each and every element of

the claimed invention. The recent Office Action fails to provide any explanation as to why one of skill in the art might be inclined to select these references; select certain compounds provided therein; and then try modify the compounds so as to arrive at the presently claimed invention. Thus, one of skill in the art would have no motivation to try to modify the compounds in the references so as to arrive at the presently-claimed compounds and then to try to explore therapeutic possibilities for these compounds as modified. Absent the present disclosure, one of skill in the art would have no way of arriving at the presently claimed invention. As a result, the Office Action has failed to make out a *prima facie* case of obviousness as is required under MPEP § 706.02(j).

Moreover, neither of these references provides any indication that the presently claimed compounds, or any other compounds, might have NMDA receptor activity. Thus, the inventors of the present discovered an unexpected beneficial result which is achieved with the claimed compounds. Even a proper showing of obviousness may be rebutted by a showing of unexpected results. Based on the unexpected results achieved with the presently claimed compounds, they are all patentable and nonobvious over the cited references.

Accordingly, reconsideration and withdrawal of the obviousness rejection are respectfully requested.

The rejection of claims 1-52 under 35 U.S.C. §102(e) over Gerlach is respectfully traversed.

The recent Office Action makes the remarkable assertion that the effective filing date of the present application for purposes of 102(e) is February 3, 2004, the filing date the present continuation application was filed rather than August 5, 2004, the date the PCT application from which the present application claims priority, was filed. The Office Action cites no authority for this proposition, and indeed there is none to be found. This proposition is entirely without support in the law.

As explained in § 2136.03(II)(B) of the MPEP, an international application may not be relied on for a 102(e) rejection if the application was not published in English. This excludes the Gerlach PCT publication as a reference. Now it appears that the Office is relying on the filing date of Gerlach's US application. However, this does not change the effective US filing date of the present application is still the PCT filing date. The requirement for publication in English is only relevant to the availability of a reference under 102(e). Whether or not a PCT application publishes in English, the PCT application is still treated as an effective US filing, *see* 37 CFR 1.601(g) and 35 USC § 120.

Accordingly, the relevant dates to compare are the filing date of the PCT parent to the present application (August, 5 2002) and the US filing date of Gerlach (August 7, 2002). Thus Gerlach is not prior art to the present application and the rejection cannot be properly maintained.

Reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of claims 1-52 under 35 U.S.C. §102(a) over Gerlach is respectfully traversed.

Applicant's previously filed certified translations of PCT application no. PCT/EP02/08729 and German application DE 101 37 488.7. These documents establish a date of invention no later than August 3, 2001 for the present application.

The publication date of the Gerlach reference, on the other hand, is August 16, 2001. Thus, the publication of the reference postdates the established invention date of the present application. Accordingly, the rejection under 102(a) cannot be properly maintained and reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket No. 029310.53175US).

Respectfully submitted,

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